



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Our Docket No.: 25629-406700)

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#8

In re the Application of)
Thomas S. Kilpela et al.)
Serial No.: 10/071,679)
Filed: February 8, 2002)
For: MULTIPLE LUMEN CRIMP)

Art Unit: 3731

Examiner: Paul Roberts

To: Mail-Stop: Non-Fee Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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RESPONSE TO OFFICE ACTION

Dear Sir:

In response to the Office Action of April 2, 2003, applicant's attorney has the following comments.

With respect to paragraph 3 of page 2 of the Office Action, the examiner argues that the Burke device teaches a pair of sidewalls that are described by other limitations of claim 1 of this application. As the examiner states: "There are two sides to item SW in the attached drawing, much the same way there are two sides to any plane."

The examiner is apparently interpreting the word "sidewalls" as comprising side surfaces of a single wall, namely the sides of the pliers.

This is clearly not what the word "sidewalls" in claim 1 means, particularly in light of the disclosure of Fig. 6, where the respective sidewalls are shown (defining recesses or troughs 60 for retaining crimp 10). A "wall" is not a surface of a wall. A pair of walls is a pair of walls, not two sides of the same wall.

Claim 1 of this application calls for “a pair of laterally positioned sidewalls and a pair of crimp retaining prongs, which the examiner argues in paragraphs 2 and 3 of the Office Action to be met by Burke ‘168. However, note the further language of claim 1: “said sidewalls defining a crimp space therebetween...”, as identified by reference numeral 58. What the examiner calls sidewalls are basically two sides of a single block: the pliers jaw. What the examiner calls in his drawing the “crimp space” is a groove which extends adjacent to each of the two surfaces that the examiner identifies as the sidewalls in his drawing. This groove is not like the “crimp space” 58 of claim 1, which is positioned “therebetween”, i.e., actually between the sidewalls. Crimp space 58 in this application is shown to clearly extend between the sidewalls. The “crimp space” 58 of Burke is not “between” the sidewalls, nor is the “crimp space” 58 of the examiner’s picture correspondingly between the sidewalls, in the sense that the actual crimp space 58 of Fig. 6 is “between the sidewalls”. Crimp space 58 of Fig. 6 is clearly bracketed on both sides by the sidewalls, i.e. actually between the sidewalls. There is no corresponding structure in the examiner’s drawing, or in Burke ‘168. Groove 58 of Burke is merely adjacent the sidewalls and not bracketed thereby. Compare Fig. 6 with the examiner’s drawing.

In paragraph 4 of the Office Action, the examiner argues that the jaws are not identical. It is presumed that the examiner is noting reference numerals 64 and 68 of Burke, which are adjacent to the upper jaw 42 of Fig. 1, and not found adjacent to the lower jaw 40. However, as stated at Burke, column 5, lines 24, *et. seq.*: “Disposed on ends 40 and 42 are respective slotted guides 64 and 66. Guide 64 is disposed on one side of apparatus 10 on end 42 directly behind recess 58, while guide 66 is disposed on the opposite side of apparatus 10 on end 40 behind recess 58.” (Emphasis added)

These guides 64, 66 are adjacent to the jaws and on one side thereof, but they are not part of the jaws. Instead, the text that we have in the Burke patent clearly indicates that the jaws are of essentially identical structure. See column 5, line 15, *et. seq.*, which reads as follows: “Ends 40 and 42 each include a recess 58. Recess 58 on each end 40 and 42 is located between an overhanging lip 60 and a lower surface 62. The two recesses 58 on ends 40 and 42 confront each other and together form one large recess sized to accept a crimp member 200...” (Emphasis added)

It can be seen that the structure of each of ends 42 and 42 is identically described. Both of them have an overhanging lip. Note that the use of “an” denotes a single lip. Also, each end 40 and 42 has “a lower surface 62”. Once again, the disclosure is singular. Looking at Fig. 1 of Burke, or the examiner’s drawing, it is clear that each overhanging lip 60 of the jaws is a single lip, by the common English of the disclosure. Similarly, lower surface 62 is possessed by each end 40 and 42, being of identical description. The sense of the disclosure has to be that the two jaws 40, and 42 are of identical structure, although each of them carry, on an opposite side from each other, a guide 64, 66.

Turning now to claim 1 of this application, how can the examiner say that such identical jaw portions comprise, in one case, “a pair of laterally positioned sidewalls and a pair of spaced crimp retaining prongs, said sidewalls defining a crimp space therebetween...” while arguing that the other of the jaw portions defines “...a single crimp gripping and crushing projection...” Two clearly identical jaw parts cannot be fairly described in such radically different ways, as the examiner is attempting to do in his interpretation of Burke. If one of the identical jaw portions of Burke has a pair of laterally positioned sidewalls, then both of the jaw portions have a pair of laterally positioned sidewalls. If one of the identical jaw portions defines a single crimp gripping

and crushing projection, then both of the jaw portions define such a projection, particularly in light of Fig. 6 of this application. Thus, it is clear that the language of claim 1 may not be construed in the manner that the examiner is attempting, to make it cover the disclosure of Burke.

The attention of the examiner is directed also to claim 2, which is dependent upon claim 1. The crimp retaining prongs are stated to “define part of the outer walls of a pair of transversely extending crimp retaining troughs”. These, of course, are troughs 60 in Fig. 6. In claim 1, the “crimp space” was identified by the examiner with reference numeral 58. However, in claim 2 this “crimp space” 58 of Burke also has to comprise the “transversely extending crimp retaining troughs” of claim 2,” as a second claim element describing the same structure. This of course, is not proper claim construction. Claim 2 is calling for a separate, new element, which is not possible by the examiner’s claim construction.

Accordingly, it is clear that proper construction of claims 1 and 2 of this application do not identify the troughs 58 of Fig. 6 with the “crimp space” of claim 1. The crimp space is, of course, identified by reference numeral 58 in Fig. 6 of this application, which is a structure that is not found in Burke, for the reasons discussed above. Rather, as defined in claim 3 of this application, the crimp space is defined by the “longitudinally extending trough in said one jaw portion”, as identified by reference numeral 58.

Also, claim 11, added in the last amendment, is dependent upon claim 6 which, in turn, is dependent upon claim 1. The examiner has rejected claim 11 and similar claims as unpatentable over Burke in view of Petersen U.S. 4,541,312. When one looks at release lever 28, which the examiner associates with the “auxiliary handle” of claim 6, this auxiliary handle is not seen to be of U-shaped cross section in Petersen, as claim 11 requires.

Accordingly, it is not understood why the examiner thinks that claim 11, and also claims 9 and 10, are unpatentable over Burke in view of Petersen.

Referring to the rejection of claims 5-8 as unpatentable over Burke 5,545,168 in view of Nelson 4,643,054 it is submitted that those skilled in the art would not be lead to make the combination that the examiner suggests. Burke does disclose an auxiliary handle 16, but it is not “pivotally mounted on one of said handles, as called for by claim 7. The handle is used to tighten wire on a capstan.

Nelson has a little handle 50 that is carried on one of the pliers’ arms, but the handle is merely for retracting a pawl 47 to disengage it from one of the notches 53 on a rack, when it is desired to open the pliers’ handles. Why would those, skilled in the art, be led to place a pawl retracting handle in the structure of Burke, which already has an auxiliary handle, and has no pawl for releasing? Furthermore, such a combination of references does not suggest the desirability of using an auxiliary handle, of approximately the length of the main handles of the pliers, to facilitate closing by a person with a small hand. It is submitted that only with that objective and improvement in mind would one be interested in making that kind of combination of the references, but in those references, there is no teaching of such. Why should a pawl releasing handle be long, and not just as it is in the Nelson patent?

It is submitted that those skilled in the art, lacking the purpose provided in this invention, would simply not be led to make any combination as suggested by the examiner, because of the absence of any purpose in doing so found in the prior art.

In view of the above, allowance of the claims is respectfully requested.

Respectfully submitted,

SEYFARTH SHAW



Garrettson Ellis
Registration No. 22,792
Attorney for Applicant

SEYFARTH SHAW
55 East Monroe Street
Suite 4200
Chicago, Illinois 60603
(312) 346-8000

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Registered Attorney for Applicant
Date: May 5, 2003